

REMARKS

The applicant respectfully requests reconsideration in view of the amendments and the following remarks. The applicant has amended claims 27 and 28 as suggested by the Examiner in order to overcome the 35 U.S.C. 112, first paragraph rejection. Support for amended claims 27 and 28 can be found in the specification at page 7, lines 26-28. The applicant believes that the amendment raises no new issues nor requires a new search.

Claims 27 and 28 are rejected under 35 U.S.C. 112, as failing to comply with the written description requirement. Claims 7-24, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jonas et. al., U.S. Patent No. 5,300,575 (“Jonas”) in view of Moehwald, U.S. Patent No. 4,728,399 (“Moehwald”). Claims 7-14 were rejected on the ground of non-statutory double patenting over claims 3-5 of copending Application No. 11/178,852 (published as US 2006/0020092). The applicant respectfully traverses these rejections.

Rejection under 35 U.S.C. 112

Claims 27 and 28 are rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. The applicant has amended claims 27 and 28 as suggested by the Examiner in order to overcome the 35 U.S.C. 112, first paragraph rejection. For the above reasons, this rejection should be withdrawn.

Rejections under 35 U.S.C. 103(a)

Claims 7-24, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jonas in view of Moehwald. The Examiner comments on our response at page 4 of the Office

Action. At page 5 of the Office Action, the Examiner stated that our showing was not a side by side comparison (comparative example 3).

A statement that modifications of the prior art to meet the claimed invention would have been “obvious to one of ordinary skill in the art at the time the invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levingood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See MPEP § 2143.01 IV. “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Furthermore, the Examiner cannot selectively pick and choose from the disclosed parameters without proper motivation as to a particular selection. The mere fact that a reference may be modified to reflect features of the claimed invention does not make the modification, and hence the claimed invention, obvious unless the prior art suggested the desirability of such modification. *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430 (Fed. Cir. 1990); *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992). Thus, it is impermissible to simply engage in a hindsight reconstruction of the claimed invention where the reference itself provides no teaching as to why the applicant’s combination would have been obvious. *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). The applicant believes that this is a hindsight reconstruction.

As stated in the previous response, a person of ordinary skill in the art would expect that fast reactions are less selective and hence should lead to more side reactions, i.e. different end

products should be obtained having different particle sizes and molar weights. A fast reaction is less controllable, i.e. the more side reactions are occurring leading to different end products.

The Examiner stated that the declaration was not a proper side by side comparison (see the second full paragraph at page 5 of the office action). The Examiner stated that the claims were not commensurate with respect to the polyanions. The applicant believes that limiting the polyanion to polystyrene sulfuric acid that the claims are commensurate in scope with the claimed invention.

Furthermore, clearly dependent claims 27 and 28 are commensurate in scope. For the above reasons, this rejection should be withdrawn.

Double Patenting Rejection

Claims 7-14 were rejected on the ground of non-statutory double patenting over claims 3-5 of copending Application No. 11/178,852 (published as US 2006/0020092). The applicant is in the process of submitting a terminal disclaimer. The undersigned is waiting for the reassignment of copending Serial No. 11/178,852 back to H.C. Starck GmbH. The undersigned notes that Serial No. 11/178,852 is being prosecuted by a different law firm.

Shortly after the assignment has been recorded the applicant will submit a terminal disclaimer.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

A one month extension of time has been paid. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 13077-00158-US from which the undersigned is authorized to draw.

Dated: July 9, 2009

Respectfully submitted,

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